REMARKS

Claims 2-20 are pending in this application. Claims 7 and 14 are independent claims. By this amendment, claims 2, 6, 7 and 9-14 are amended and claim 1 is canceled without prejudice or disclaimer thereto. In addition, the Title of the application is amended.

Reconsideration in view of the above amendments and following remarks is respectfully solicited.

Copies of Initialed PTO-1449 Requested

Applicants respectfully request a copy of the initialed PTO-1449 submitted on April 5, 2001.

In reviewing the application file, the undersigned has noted that the appropriate initialed Form PTO-1449 in response to the Information Disclosure Statement (IDS) filed on April 5, 2001 has not been received by Applicants. The Examiner is therefore requested to return a copy of the initialed Form PTO-1449 to the undersigned as soon as possible.

Allowable Subject Matter

Applicants gratefully acknowledge the Examiner's indication of allowable subject matter in claims 7 and 8 over the art of record. (Claim 9 is also assumed to be allowable but for the 112, 2nd rejection pertaining thereto).

The Office Action also indicates that claims 7 and 8 are objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants respectfully point out that by this amendment allowable claim 7 is now rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Accordingly, independent claim 7, and claims dependent thereon, are now in condition for allowance. An early indication of the same is greatly appreciated.

The Claims Satisfy The Requirements Of
35 U.S.C. §112, 2nd Paragraph

The Office Action rejects claim 9 under 35 U.S.C. §112, 2nd paragraph. This rejection is respectfully traversed.

Applicants respectfully submit that the amendment to claim 9 obviates the rejection of claim 9 under 35 U.S.C. §112, 2nd paragraph.

In particular, the amended claim 9 now provides proper antecedent basis for the limitation "reference period of time."

Accordingly, withdrawal of the rejection of claim 9 under 35 U.S.C. §112, 2nd paragraph is respectfully requested.

The Claims Define Patentable Subject Matter

The Office Action rejects:

(1) claims 1-4, 6, 10-12 and 14-17 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,567,125 to Shimizu (hereafter Shimizu);

(2) claim 5 under 35 U.S.C. §103(a) as being unpatentable over Shimizu in view of U.S. Patent No. 6,151,073 to Steinberg et al. (hereafter Steinberg); and

(3) claims 13 and 18-20 under 35 U.S.C. §103(a) as being unpatentable over Shimizu in view of U.S. Patent No. 5,008,757 to Kimura et al. (hereafter Kimura).

These rejections are respectfully traversed.

Applicants respectfully submit that each of the above noted rejections are moot in light of the incorporation of allowable subject matter into independent claims 7 and 14.

Specifically, as noted above, allowable claim 7 is rewritten into independent form. Similarly, independent claim 14 is amended to include similar allowable subject matter of claim 7.

Applicants respectfully submit that, as conceded by the Examiner, the cited references, Shimizu, Steinberg and Kimura, each fail to teach or suggest that the controller determines an exposure time in accordance with an exposure value for shooting a desired scene and feeds the second control signals to the switching circuit at a timing matching with the exposure time to thereby cause the switching circuit to drive the outputting circuit at a low voltage. (see Office Action, page 12, paragraph 11).

According to MPEP §2131, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ...claims." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913 (Fed. Cir. 1989). The elements must be arranged as required by the claims, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Applicants respectfully submit that the Office Action has failed to establish the required *prima facie* case of anticipation because the cited reference, Shimizu, fails to teach or suggest each and every feature as set forth in the claimed invention.

Applicants respectfully submit that independent claims 7 and 14 are allowable over Shimizu for at least the reasons noted above.

As for each of the dependent claims not particularly discussed above, these claims are also allowable for at least the reasons set forth above regarding their corresponding independent claims, and/or for the further features claimed therein.

Accordingly, withdrawal of the rejection of claims 1-4, 6, 10-12 and 14-17 under 35 U.S.C. §102(e) is respectfully solicited.

In addition, Applicants respectfully submit that both Steinberg and Kimura fail to make up for the deficiencies found in Shimizu.

Applicants respectfully submit that neither Shimizu, Steinberg nor Kimura, taken singularly or in combination, (assuming these teachings may be combined, which applicants do not admit) teach or suggest that the controller determines an exposure time in accordance with an exposure value for shooting a desired scene and feeds the second control signals to the switching circuit at a timing matching with the exposure time to thereby cause the switching circuit

to drive the outputting circuit at a low voltage . In fact, the Examiner has indicated that such a feature is allowable. (see Office Action, page 12).

To establish a *prima facie* case of Obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

Applicants respectfully submit that not only does the combination of references fail to teach or suggest each and every feature as set forth in the claimed invention, but that one of ordinary skill in the art would not have been motivated to combine/modify the teachings of such references because there is no teaching or suggestion in any of the references regarding how or why one would modify such systems to arrive at the claimed invention.

Accordingly, withdrawal of the rejection of claims 5, 13 and 18-20 under 35 U.S.C. §103(a) is respectfully requested.

Conclusion

In view of the foregoing, Applicants respectfully submit that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Carolyn T. Baumgardner (Reg. No. 41,345) at (703) 205-8000 **to schedule a Personal Interview**.

MKM/CTB/mpe

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment from or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17; particularly, the extension of time fees.

Dated: May 12, 2005

Respectfully submitted,

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